

REMARKS/ARGUMENTS

Applicants gratefully acknowledge the telephone interview which was granted by the Examiner on August 27, 2003. Applicants thank the Examiner for reconsidering the amendment which was presented in the response mailed on July 21, 2003 and had not been entered according to the Advisory Action.

During the interview, Applicants indicated that the amendment to claim 46 was made as a result of a suggestion by the Examiner in the Final Office Action mailed on April 21, 2003 (see page 10; first paragraph). Therein, the Examiner indicated that the specification discloses a minimum number of species, *e.g.*, HIV gag and HIV env, and that the specification does not support the broad genus of the claims. Applicants also indicated that the amendment did not raise new consideration and search (as was presented in the Advisory Action) because no prior art was cited against the broader genus claims. The Examiner agreed to reconsider Applicants' position on submission of a second response after final. Thus, Applicants respectfully request that the instant claim amendment be entered.

Claims 46-49 are pending in the application. Claim 46 has been amended. Claims 47 and 48 depend directly or indirectly on amended claim 46. No new matter was added by this amendment. Claims 1, 2, 6-20, 22, 25-29 and 31-33 are canceled without prejudice to subsequent revival. The amendments should not be construed as an acquiescence in any grounds of rejection.

Double Patenting

According to the Advisory Action, the submitted terminal disclaimer has overcome the cited double patenting rejections. Therefore, it is assumed no further action is needed by Applicants with respect to this issue.

Appl. No. 09/943,722
Amdt. dated September 22, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

Rejection Under 35 U.S.C. §112

Claims 46-48 were rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have amended claim 46 to refer to a synthetic gene which encodes a "HIV-1 gag or HIV-1 env" protein. Claims 47 and 48 depend directly or indirectly on amended claim 46. Support for this amendment can be found on page 10, lines 28-30; page 11, lines 3-5; page 12, lines 22-23; page 16, line 31; page 22, line 35; page 35, lines 27-35; page 40, lines 18-20; page 43, line 29; and throughout the specification. No new matter was added by this amendment. The rejection was discussed with the Examiner during the interview (see comments above). In light of the interview, this rejection should be moot. Thus, Applicants respectfully request withdrawal of the rejection of claims 46-48 under 35 U.S.C. §112, first paragraph.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Brigitte A. Hajos
Reg. No. 50,971

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachments
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